

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 6/21/03

APPL. S.N.: 09, 713, 794

TO EXAMINER: Lambertson

ART UNIT: 1636

ROOM \_\_\_\_\_

MAILROOM DATE 6/19/03

AFTER FINAL YES \_\_\_\_\_ NO X NUMBER OF T.D(S). FILED \_\_\_\_\_

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl, or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: \_\_\_\_\_

☐ Suggestion to request refund of \$ \_\_\_\_\_. (See 14.35, 14.36).

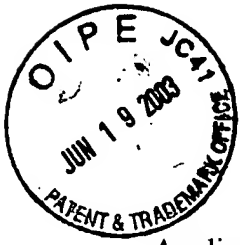
☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



A32000-A (072667.0172)

PATENT

#12

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Batard *et al.*

Serial No. : 09/713,794 Examiner: Lambertson, David A.

Filed : November 15, 2000 Group Art Unit: 1636

For : THE RECODING OF DNA SEQUENCES TO ENABLE THEM TO BE  
EXPRESSED IN YEASTS, AND THE TRANSFORMED YEASTS  
OBTAINED

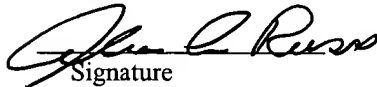
RECEIVED  
JUN 20 2003  
TECH CENTER 1600/2900

TERMINAL DISCLAIMER

I hereby certify that this paper is being deposited on June 17, 2003 with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450

Alicia A. Russo  
Attorney Name

46,192  
PTO Registration No.

  
Signature

June 17, 2003  
Date of Signature

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Assignee, the Bayer Cropsciences, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term, defined in 35 U.S.C. §§ 154-156 and 173, as presently shortened by any terminal disclaimer, of commonly owned prior U.S. Patent No. 6,180,363, which issued on January 30, 2001 from U.S. Patent Application Serial No. 09/158,767, filed on July 25, 1996.

The Assignee hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that it and U.S. Patent No. 6,180,363 are commonly owned. The Assignee further agrees that this agreement is to run with any patent

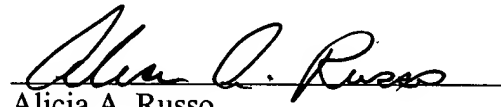
granted on the above-identified application and is to be binding upon the grantee, its successors, and assigns.

In making the above disclaimer, the Assignee does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173 of U.S. Patent No. 6,180,363 in the event that U.S. Patent No. 6,180,363: (i) expires for failure to pay a maintenance fee; (ii) is held unenforceable; (iii) is found invalid by a court of competent jurisdiction; (iv) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321; (v) has all claims canceled by a reexamination certificate; (vi) is reissued; or (vii) is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned attorney of record hereby confirms that she is empowered to act on behalf of the Assignee.

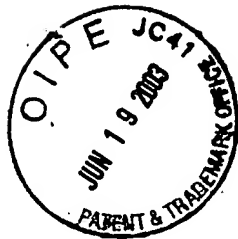
Respectfully submitted,

BAKER BOTTS L.L.P.

A handwritten signature in cursive script, appearing to read "Alicia A. Russo", is written over a horizontal line.

Alicia A. Russo  
PTO Registration No. 46,192

Attorney for Applicants  
(212) 408-2627



16364

A31644-PCT-USA-II (072900.0110)  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Batard *et al.*  
Serial No. : 09/713,794 Examiner: Lambertson, David A.  
Filed : November 15, 2000 Group Art Unit: 1636  
For : THE RECODING OF DNA SEQUENCES TO ENABLE THEM TO BE  
EXPRESSED IN YEASTS, AND THE TRANSFORMED YEASTS  
OBTAINED


RECEIVED  
JUN 20 2003  
TECH CENTER 1600/2900

**TERMINAL DISCLOSURE FEE SHEET**

I hereby certify that this paper is being deposited on June 17, 2003 with the United States Postal Service as first class mail in an envelope addressed to:  
Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Alicia A. Russo  
Attorney Name

46,192  
PTO Registration No.

  
Signature

June 17, 2003  
Date of Signature

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:


Pursuant to 37 C.F.R. §§ 1.321(a) and 1.20(d), the fee for processing the attached Terminal Disclaimer for a small entity is believed to be \$110.00.

A31644-PCT-USA-II (072900.0110)  
PATENT

The Commissioner is hereby authorized to charge the \$110.00 fee as well as any additional filing fees associated with this communication or credit any overpayment to Deposit Account No. 02-4377. Two copies of this paper are enclosed.

Respectfully submitted,

BAKER BOTTS L.L.P.



Alicia A. Russo  
PTO Registration No. 46,192

Attorney for Applicants

30 Rockefeller Plaza, 45<sup>th</sup> Floor  
New York, NY 10112-4498  
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